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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,477	09/27/1999	CHARLES E. HILL	45607-65055	1650

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EXAMINER
BROWN, TIMOTHY M

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 11/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/406,477	HILL, CHARLES E.	
	Examiner	Art Unit	
	Tim Brown	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *27 August 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This Final Office Action is in response to Applicant's amendment submitted August 27, 2002.

Claim Rejections - 35 USC § 112

2. The rejection of claims 2, 8, 9, 11, 18 and 20 made under 35 U.S.C. §112 have been withdrawn in response to Applicant's amendment.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-7 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIECHA (US 5,870,717) in view of CAMERON et al. (US 5,592,378).

Regarding claims 1 and 10, Weicha teaches a method and apparatus for presenting a plurality of product images for review by a user on a computer including a display, a memory, and an input device, the method and apparatus comprising: displaying a plurality of product images on the display (col. 3, lines 10-12 and 19-21); providing a side-by-side comparison of selected products (col. 3, lines 18-24); receiving a user input selecting a product image from the plurality of product images displayed on the display (col. 3, lines 18-19); and displaying the selected products for a side-by-side comparison with at least one other selected product (col. 3, lines 18-24).

Further regarding claims 1 and 10, Weicha does not specifically teach providing product image review boxes on the display for facilitating the side-by-side comparison of

the product images. However Cameron et al. teach this limitation (*see* Figures 18 and 19). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha, to include providing product review boxes for facilitating a side-by-side comparison of selected product images because product review boxes would clearly segregate the selected items and provide a more user-friendly interface than that taught by Wiecha.

Regarding claims 2 and 11, Wiecha and Cameron et al. teach all the limitations discussed under claims 1 and 10 above. Further regarding claims 2 and 11, Wiecha does not specifically teach the displaying a plurality of product images by displaying a scroll box on the display which includes the plurality of product images from a selected product category. However, Cameron et al. teach the use of a product box to present a user with product names from the selected product category (col. 13, lines 64-67; col. 14, lines 1-6; and Figure 18). As for scrolling and the use of product images within the product box, Official Notice is taken that these limitations were notoriously well-known in the art of product display. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha with both Cameron et al.'s use of a product box for the display of products from a selected category, and the well-known concepts of the of scrolling and the use of product images in order to provide users with a easier means by which to browse and select products offered by vendors.

Regarding claims 3 and 12, Wiecha and Cameron et al. teach all the limitations discussed under claims 2 and 11 above. Further regarding claims 3 and 12, neither

Wiecha nor Cameron et al. specifically teach displaying a plurality of product images wherein the product images in the review boxes are larger than the product images in the scroll box. However, Official Notice is taken that this limitation was notoriously well-known in the art of product display at the time of the applicant's invention. One of ordinary skill in the art would have been motivated to modify the method taught by Wiecha and Cameron et al. to include displaying a plurality of product images that are larger than the product images in the scroll box because this combination would permit a user to quickly browse products contained within the scroll box.

Regarding claims 4 and 13, Wiecha and Cameron et al. teach all the limitations discussed under claims 1 and 10 above. Further regarding claims 4 and 13, Wiecha does not specifically teach displaying a plurality of product images wherein selected product images are displayed in the next available review box until all the review boxes are filled with product images, and wherein the next selected product image replaces the product image in one of the review boxes. However Cameron et al. teach this limitation (col. 13, lines 53-67; and col. 14, lines 1-21). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha to include a method of displaying a plurality of product images wherein selected product images are displayed in the next available review box until all the review boxes are filled with product images, and wherein the next selected product image replaces the product image in one of the review boxes. One of ordinary skill in the art would have been motivated modify Wiecha in this manner in order to allow a user to perform a side-by-side comparison of a greater number of products.

Regarding claims 5 and 14, Wiecha and Cameron et al. teach all the limitations discussed under claims 4 and 13 above. Further regarding claims 5 and 14, neither Wiecha nor Cameron et al. specifically teach presenting a plurality of product images wherein the user selects the review box in which to replace the product image after all the review boxes are filled with product images. However, the examiner takes Official Notice that selecting a review box in which replace a product image was notoriously well-known in the art of product display at the time of the applicant's invention. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha and Cameron et al., to include a step wherein the user selects a product review box in which to display the next-selected product image. One of ordinary skill in the art would have been motivated to modify Wiecha and Cameron et al. to allow a user to select a product review box for display of the next-selected item as this would allow the user to retain product images of interest for comparison with the next-selected product image.

Regarding claims 6 and 15, Wiecha and Cameron teach all the limitations discussed under claims 1 and 10 above. Further regarding claims 6 and 15, Wiecha further teaches receiving a user input to order a selected product displayed on the display, and automatically generating an order for the selected product (col. 3, lines 30-34).

Regarding claims 7 and 16, Wiecha and Cameron et al. teach all the limitations discussed under claims 6 and 15 above. Further regarding claims 7 and 16, Wiecha further teaches the step of automatically transmitting the order form for the selected

product from the computer to a vendor's computer located at a remote location (col. 3, lines 30-34).

5. Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIECHA (US 5,870,717) in view of CAMERON et al. (US 5,592,378) as discussed under claims 1 and 10 above, and further in view of MIZOKAWA (US 4,530,009).

Regarding claims 8 and 17, Wiecha teaches all the limitations discussed under claim 1 above. Wiecha does not specifically teach a method or apparatus wherein the plurality of product images includes at least one product image and at least one background image, and the step of displaying the selected product image includes integrating a product image with a background image to provide a customized product image on the display. However, Mizokawa teaches this limitation (col. 3, lines 35-49; *see also* abstract). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha, to include creating a customized product image as taught by Mizokawa because the addition of this step would allow a user to perform a side-by-side comparison of one or more customized product images whose components may vary based upon user input.

6. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIECHA (US 5,870,717) in view of CAMERON et al. (US 5,592,378) and MIZOKAWA (US 4,530,009) as discussed under claims 8 and 17 above, and further in view of Gray et al. (US 4,661,811).

Regarding claims 9 and 18, neither Wiecha, Cameron et al. nor Mizokawa specifically teach a method or apparatus wherein the product image and the selected background image are integrated based on a map. However, Gray et. al teach this limitation (col. 1, lines 11-13; and col. 2, lines 20-36). The examiner takes Official Notice that transmitting a map or similar instructions to a user computer from a vendor's computer at a remote location was notoriously well-known in the art at the time of the applicant's invention. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha, Cameron et al. and Mizokawa, to include the use of a map to integrate the product and background image wherein the map is transmitted from a remote location. Transmitting a map, from a remotely located vendor, for integrating the product and background images would allow a vendor to provide a suggested product composition thereby allowing the user to create a customized a product based upon a vendor's guidelines.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over WIECHA (US 5,870,717) in view of MIZOKAWA (US 4,530,009).

Wiecha teaches an apparatus for displaying a product image for review by a user, the apparatus comprising: a computer including a display, a memory, and an input device (col. 3, lnes 10-21); means for storing a plurality of product images in the memory of the computer (col. 3, lines 10-17; col. 5, lines 30-67; and col. 6, lines 1-25); means for storing a plurality of background images in the memory of the computer (col. 3, lines 10-17; col. 5, lines 30-67; and col. 6, lines 1-25); means for selecting one of the background images to be displayed on the display with each product image (col. 3, lines

18-34); and a means for receiving a user input to display a selected product image (col. 3, lines 10-34).

Wiecha does not specifically teach a means for integrating the selected product image with the selected background image on the display to provide a customized product image on the display. However, Mizokawa teaches this limitation (col. 3, lines 35-49; *see also* abstract). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha, to include a means for providing a customized product image as taught in Mizokawa as this would allow a user to create a customized product derived from components offered by a vendor.

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over WIECHA (US 5,870,717) in view of MIZOKAWA (US 4,530,009) as discussed under claim 19 above, and further in view of Gray et al. (US 4,661,811).

Neither Wiecha nor Mizokawa specifically teach an apparatus of wherein the product image and the selected background image are integrated by the integrating means based on a map. However, Gray et al. teach this limitation (col. 1, lines 11-13; and col. 2, lines 20-36). The examiner takes Official Notice that transmitting a map or similar instructions to a user computer from a vendor's computer at a remote location was notoriously well-known in the art at the time of the applicant's invention. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha and Mizokawa, to include the use of a map to integrate the product and background image wherein the map is transmitted

from a vendor at a remote location. Transmitting a map, from a remotely-located vendor, for the purpose of integrating the product and background images, would allow a vendor to provide a suggested product composition thereby allowing the user to create a customized a product based upon a vendor's guidelines.

Terminal Disclaimer

9. The terminal disclaimer filed on August 27, 2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 5970471 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

10. Applicant's arguments filed August 27, 2002 have been fully considered but they are not persuasive.

11. Regarding independent claims 1 and 10, Applicant argues that neither Wiecha (US 5,870,717) nor Cameron et al. (US 5,592,378) ("Cameron") teach "displaying product review images in review boxes for side-by-side comparison . . . ." (Amendment, p. 4). The Examiner agrees Wiecha does not teach this feature. This was stated in page 4 of the Office Action. However, Wiecha is not offered for teaching displaying product review images in review boxes for side-by-side comparison. Rather, it was Cameron (US 5,592,378) that was offered for disclosing this feature. (*See* Office Action, p. 4). In that regard, Cameron discloses a computerized order entry system comprising a system interface with a plurality of buttons representing order entry functions (Abstract). One of the order entry functions is to provide users with a side-by-

side comparison of images representing order sources (col. 13, lines 43-67). Thus, Cameron teaches displaying product review images in review boxes for side-by-side comparison.

12. Regarding independent claim 19, Applicant argues Mizokawa (4,530,009) is unrelated to his invention. (Amendment, p. 4).[1] Applicant points out, that in Mizokawa, the foreground picture varies continuously with the display and the background picture is shot with a video camera. (Id.). The Examiner asserts Mizokawa is related to the invention of claim 19. First, lines 12 and 13 of claim 19 recite "a means for integrating the selected product image with the selected background image . . . ." Therefore, claim 19 does not recite any limitations that would exclude a foreground picture that varies continuously or a background picture that is shot with a video camera. Second, both Mizokawa and the claimed invention depend on the use of computers for displaying a merged image. As in the claimed invention, the foreground picture displayed in Mizokawa is "based on data processed by the computer . . . ." (Col. 2, lines 65-66). Third, Applicant cited Mizokawa in an Information Disclosure (Paper No. 2) statement pursuant to 37 C.F.R. 1.56. According to 37 C.F.R. 1.56 each individual associated with the filing and prosecution of a patent application has a duty to disclose to the Office all information known to that individual to be material to patentability. Applicant would not have cited Mizokawa unless it was material to the patentability of the claimed invention. Therefore, for at least the preceding reasons, Mizokawa is related to the invention of claim 19.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Yoda (US 5,515,268) May 7, 1996; a method for ordering clothing wherein product images are merged with the image of a person (Abstract; and col. 5, lines 49-60)

b. Hutton (US 5,440,479) August 8, 1995; an apparatus for permitting users to create a floral arrangement from a remote location (Abstract; col. 2, lines 27-44; and col. 4, lines 62-67)

c. Spackova et al. (US 4,539,585) September 3, 1985; a system for previewing articles of clothing wherein images of the articles are superimposed on the capture image of a user

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

[1] The Examiner notes claim 19 was inadvertently included in the rejection statement in paragraph 11 of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (703) 305-1912. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Tim Brown
Examiner
Art Unit 3625

TB
November 14, 2002

JEFFREY A. SMITH
PRIMARY EXAMINER

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the Office Action.

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.